

REMARKS

This is in response to the Office Action dated July 2, 2004.

Summary of Office Action

In the Office Action, the Examiner made a restriction requirement under 35 U.S.C. 121 directing the Applicant to elect between two distinct inventions, namely, Claims 1-14 and Claims 15-20. Additionally, the Examiner required the Applicant to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable, namely species I-III and species A-C. Moreover, Claims 1-7 were rejected under 35 U.S.C. 102() as being anticipated by U.S. Patent No. 6,123,711 issued to Winters. Further, Claims 9 and 13-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Winters in view of U.S. Patent No. 4,988,351 issued to Paulos et al. based on a contention that it would have been obvious to one of ordinary skill in the art at the time the invention was made (1) to modify the Winters device as taught by Paulos et al. because titanium is biocompatible, strong and light weighing and (2) to make the Winters device having the dimensions specified by Paulos et al. in order to effectively attach the threaded fastener within the bone, as understood.

Claim 8 was objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's Response

Restriction Requirement

In the Office Action, the Examiner made a restriction requirement requiring the Applicant to elect from two distinct inventions and a plurality of species. In this regard, Applicant, by this Response, affirms the election made without traverse during the telephone conversation with Kit M. Stetina, Esq. to prosecute the invention Group I, Species I and A, namely, Claims 1-9 and 12-14. Furthermore, as shown above, Applicant respectfully requests cancellation of Claims 11-12 and 15-20, without prejudice.

Claim 1-7, 9 and 12-14

In the Office Action, Claim 1 was rejected under 35 U.S.C. 102 as being anticipated by Winters. In response, Applicant has amended Claim 1 to further recite that the proximal anchor has a "rounded outer surface portion" and the adjustable flange has a "spherically recessed

portion” sized and configured to receive the rounded outer surface. In this regard, as understood, the Winters disclosure does not disclose the spherically recessed portion of the adjustable flange and the “receive” interaction between the rounded outer surface portion and the spherically recessed portion. In support thereof, Applicant directs the Examiner’s attention to Fig. 1 and additionally to the exemplar figure shown on the face the Winters patent. In this regard, these figures do not show the adjustable flange with a spherically recessed portion; rather, the adjustable flange of the Winters disclosure has a cylindrical portion, as shown in the referred to figures, as understood.

Moreover, since the Winters disclosure does not disclose the spherically recessed portion, the same cannot disclose any interaction between a rounded outer surface portion of the proximal anchor and the undisclosed spherically recessed portion, as understood. This interaction between the spherically recessed portion and the rounded outer surface portion enables the proximal anchor to rotate with respect to the flange and the flange to be positioned at a variable angle with respect to the body.

In this regard, the Winters disclosure and its disclosed corresponding structure do not enable the flange to be positioned at a variable angle with respect to the body. As understood, in the Office Action, the Examiner stated that “the gap [41] allows the adjustable flange 40 to be positioned at a variable angle.”¹ However, even though the gap may allow the adjustable flange to be positioned at a variable angle, such mere possibilities are not sufficient to establish that the Winters disclosure discloses such characteristic. In other words, the Examiner’s construction of the disclosure of Winters may be too broad, as understood. In particular, it appears that the figures show that the gap allows the flange to be positioned at variable angles with respect to the body. However, this conclusion, as understood, is based on the Figures alone and not in conjunction with its corresponding text. If the figures alone were the basis for the conclusion that the flange and body may be set at variable angles, then one must also assume other consistent characteristics of the teachings of Winters such as the anchor passing through the gap. Since this is not a plausible result based on the intended use of the device of Winters, the opposite must be true, as understood. In other words, as understood, the anchor must be larger than shown such that the anchor does not pass through the gap. If the anchor is larger than

¹ Office Action mailed July 2, 2004, page 4

shown, then perhaps the flange may not be positioned at variable angles with respect to the body. Accordingly, the interaction between the flange and body should be construed in view of the corresponding text in its disclosure.

Column 4, lines 20-25 of the Winters disclosure states that the anchor and flange are decoupled in at least one degree of freedom, as understood. The first degree of freedom may be construed as the rotational movement between the anchor and flange, as stated in column 4, ln. 21 of Winters. However, the disclosure is absent as to the other degrees of freedom between the flange and anchor, as understood. In this regard, as understood, the second degree of freedom may be the axial movement of the anchor with respect to the flange via the gap and not a variable angle between the flange and body. As such, an alternative plausible construction based on the figures and its corresponding text is that “at least one degree of freedom” may include (1) rotation and (2) linear movement of the anchor through the gap. Accordingly, as understood, the Examiner’s attempt to characterize the gap as allowing the flange to be positioned at a variable angle with respect to the body may be too broad in view of the text of Winters and that there is no suggestion in the text that the flange is positionable at variable angles with respect to the body. Hence, the Winters patent does not disclose Claim 1 as amended.

Moreover, even if a reference discloses a spherically recessed portion, there is no motivation to modify the teachings of Winters (1) to include the spherically recessed portion and (2) to size and configure the spherically recessed portion to receive the rounded outer surface portion. In support thereof, Applicant respectfully directs the Examiner’s attention to Fig. 1 of Winters. As understood, as shown in Fig. 1, if the flange was modified to have a spherically recessed portion, then the flange and body may still not be positionable at variable angles based on a view that the base of the anchor (i.e., cylindrical shaft portion) may still interfere with a lower lip formed by the spherically recessed portion in the flange. Accordingly, modification of the teachings disclosed in Winters does not appear to produce the benefit of allowing the flange to be positioned at variable angles with respect to the body.

Further, there is no motivation to modify the teachings of Winters to include the spherically recessed portion and to size and configure the spherically recessed portion to receive a rounded outer surface based on a view that such modification may render the device inoperable for its intended use. The intended use of the device being, as understood, attachment of a

ligament to a bone. However, the aforementioned modification would or may render the flange weak such that stresses at the contact point between the rounded outer surface portion and the spherically recessed portion would break the flange, and more particularly, the lip such that the rounded outer surface portion would release through the spherically recessed portion. Such breakage would render the device inoperable as an anchor (e.g., attachment of ligament to bone). Accordingly, there is no motivation to modify the teachings of Winters to the structure as recited in amended Claim 1. In this regard, Applicant respectfully submits that amended Claim 1 is in condition for allowance.

The dependent claims are also believed to contain additional patentable subject matter. For example, new Claim 21 recites that the proximal anchor is split. In this regard, the specification of Winters does not disclose the proximal anchor as being split. Rather, the proximal anchor disclosed in Winters is whole. Furthermore, there is no motivation to modify the teachings of Winters such that its proximal anchor is split based on a view that to do so would render the device of Winters inoperable for its intended use, as understood. In particular, as understood, if the proximal anchor disclosed in Winters were to be modified such that it is split, then the proximal anchor may compress with respect to its diameter so as to reduce its head diameter to thereby allow the proximal anchor to pass through the gap 41 (i.e., making the device of Winters inoperable for its intended use). Hence, Applicant respectfully submits that the dependent claims of Claim 1 namely Claim 2-7, 9, 12-14 and 21 are also in a condition for allowance.

Allowable Claim 8

In the Office Action, Claim 8 was objected to as being dependent upon a rejected base claim. However, the Examiner indicated that Claim 8 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, Applicant has amended Claim 8 to be an independent form and have included all of the limitations of its base Claim 1, as originally filed. Hence, Applicant respectfully submits that amended Claim 8 is now in condition for allowance.

Conclusion

For the foregoing reasons, Applicant respectfully submits that all the stated grounds of rejection and objection have been overcome, and that Claims 1-9, 12-14 and 21 are in condition for allowance. An early notice of allowance is therefore respectfully requested.

Should the Examiner have any suggestions for expediting allowance of the application, the Examiner is invited to contact the Applicant's representative at the number listed below.

If any additional fee is required, please charge Deposit Account Number 19-4330.

Respectfully submitted,



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By:

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